

Remarks

This paper responds to the first Office Action in the above-entitled application, mailed June 13, 2005, and allowing one month for a response. This response is timely because it is being filed within the period set for a response.

Restriction Requirement

The Office Action groups the 37 claims of the present application to four groups: I. Claims 1-9; II. Claims 10-20; III. Claims 21-27; and IV. Claims 28-37. The Office Action then holds that the inventions represented by the four groups are distinct, each from the other, and is requiring the Applicants to limit this application to one of the four groups. An election of claims 1-9 to be examined has been made with traverse.

The Office Action based its restriction requirement on its finding that “[i]nventions I, II, III, and IV are unrelated.” However, as the Manual of Patent Examination Procedure (“MPEP”) provides, “This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.” MPEP, § 808.01, page 800-47 (8th Ed. Rev. 2, 2004). The present application is not such a “rarely presented” situation, because inventions I, II, III, and IV are all related and recite a corrosion inhibitor and a corrosive composition, which can be, for example, a composition containing conductive carbon or a base.

Furthermore, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” MPEP § 803, page 800-4. Even assuming, for purpose of argument, that the four groups of inventions, although related, are patentably distinct, one of the “two criteria for a proper requirement for restriction between patentably distinct inventions” is that “[t]here must be a serious burden on the examiner if restriction is not required” MPEP § 803,

page 800-4 (emphasis added). The fields of search required to search the respective compositions of Groups I and II, and methods of Groups III and IV are essentially coextensive, because they are all related to a corrosive composition and a corrosion inhibitor. Therefore, there will be no serious burden on the examiner to examine all claims (1-37).

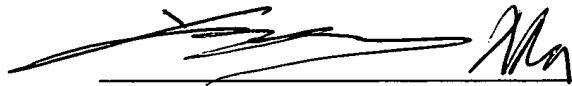
Conclusion

The Examiner is respectfully requested to withdraw the restriction requirement and examine all claims (1-37) of the present application. As an alternative, claims 1-9 have been elected for examination.

The Commissioner is hereby authorized to charge any additional fees which are presently required, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

DATE: July 13, 2005



Yufeng Ma
Reg. No. 56,975
Attorney for Applicants

MCANDREWS, HELD & MALLOY, LTD.
500 W. Madison, 34th Floor
Chicago, IL 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100